REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 6, 2010. At the time of the Office Action, Claims 39-62 were pending in this Application. Claims 39-62 were rejected. Claims 39 and 49 have been amended. Claims 1–38 were previously cancelled without prejudice. Applicants respectfully request reconsideration and favorable action in this case.

Examiner Interview

Applicants participated in a telephonic interview on March 15, 2010 with the Examiner and have the understanding that the Examiner will provide a summary of the discussion. In the event that Applicants misunderstood the conversation or are subsequently asked to provide a summary, one will be provided.

Rejections under 35 U.S.C. § 103

Claims 39-62 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0193967 filed by Gregg Fenton et al. ("*Fenton*") in view of RFC 22 Standard for the Format of ARPA Internet Text Messages ("*RFC 822*"). In addition, the Examiner points to U.S. Patent No. 6,374,292 issued to Srivastava et al. ("*Srivastava*") for further explanation of what RFC 822 discloses.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on

ex post reasoning. *KSR*, 127 S. Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1741).

Applicants have amended independent Claims 39 and 49 and respectfully submit that the proposed combination of *Fenton* and *RFC 822* does not render obvious the present claims. For example, the proposed combination of *Fenton* and *RFC 822* does not teach at least the following features of amended independent Claim 39:

> transmitting a message from a first message service provider to a second message service provider, wherein the message contains at least a first header field which includes a reference to a specific network element of the first message service provider, which was involved in processing the message, and
>
> evaluating the message at the second message service provider, and
>
> transmitting a confirmation message from the second message service provider directly to the specific network element of the first message service provider as identified by the first header field.

Independent Claim 49 has similar features. Specifically, the proposed combination of *Fenton* and *RFC 822* does not teach ***transmitting a confirmation message from the second message service provider directly to the specific network element of the first message service provider as identified by the first header field.***

The focus of Applicants claimed invention is clear from the claims and the specification: to allow a network element of Service Provider B to send a message directly to a network element of Service Provider A confirming the receipt of a message originally sent by User Agent A. This confirmation message transverses only the MM4 interface (between network service providers) and is sent directly to a *specific* network element of service provider A that is ***identified by the first header field*** of the message. This claimed feature allows, for example, the handling of complex billing policies that might allow User Agent A to pay for a reply message of User Agent B back to User Agent A. The specifically identified network element within service provider A may be specially configured to handle that

protocol and to retain the appropriate accounting records. Further, the claims are crystal clear that they do not involve transmitting a confirmation message across the MM1 interface (between a user and his/her network service provider).

Fenton

Turning to the cited references, *Fenton* discusses headers identifying the originating and destination *user agents* in order to allow return transmissions. *Fenton*, ¶¶ [0053], [0070]. These user agents 1008 and 1018 (i.e., cell phones, smart phones, and other end-user communication terminals) are clearly outside the boundary of the message service providers 1002 and 1004. *Fenton*, fig. 10. These return transmissions would have to cross the MM1 interface in order to reach the original user who sent the message. Thus, any teaching or suggestion in *Fenton* of sending a message back to user agent A 1008 cannot satisfy a limitation requiring *transmitting a confirmation message from the second message service provider directly to the specific network element of the first message service provider*. The Examiner has not cited to a teaching or suggestion in *Fenton* for this direct communication between a network element of the second message service provider and a network element of the first message service provider because such a teaching or suggestion cannot be found in *Fenton*. The Examiner appears to concede this point. Office Action at 4 ("Fenton specifically fails to indicate, 'that may be specifically addressed by the second message service provider as a result of processing the message or a response to the message." (emphasis in original)).

RFC 822

Next, the Examiner turns to *RFC 822*. However, nothing in *RFC 822* teaches or suggests *transmitting a confirmation message from the second message service provider directly to the specific network element of the first message service provider as identified by the first header field*. At most, *RFC 822* indicates that a return message to the original message sender is possible, but such a return message adds nothing to the disclosure of *Fenton*. The Examiner continues to focus on the "Return-Path" field in *RFC 822*, but this field cannot provide this teaching or suggesting for at least two fundamental reasons.

First, the return-path of a message is simply an unadorned, ordered list of each network element (e.g., each end user client, mail server, list server, router, etc.) that processed

or relayed the message. The return-path field includes no specific information identifying a particular entry as a specific network element in the first message provider. This specific identification is required by Applicants' claims wherein the *specific network element of the first message service provider* is *identified by the first header field*. The Examiner does not point to an explanation of how or why a person of ordinary skill in the art would, in view of *RFC 822*, be able to identify and directly contact the *specific network element of the first message service provider, which was involved in processing the message* among a sequential list of network addresses.

Second, the ordered list contained in the return-path field of *RFC 822* is generated by "the final transport system *that delivers the message to its recipient*." Office Action at 5 (quoting *RFC 822*) (emphasis added). Yet, the claim language requires the message—in the form transmitted from the first message service provider to the second message service provider—to already include *a reference to a specific network element of the first message service provider, which was involved in processing the message*.

As with *Fenton*, the Examiner has not cited to a teaching or suggestion in *RFC 822* for this direct communication between a network element of the second message service provider and a network element of the first message service provider because no such teaching exists. It is worth noting that *Srivastava* adds nothing of substance to this discussion and is merely cumulative of *RFC 822* and/or *Fenton*. As neither of the references in the proposed combination teach or suggest each of the claimed features, the combination cannot be said to do so.

Therefore, Applicants respectfully request reconsideration and allowance of amended independent Claims 39 and 49; and Claims 38–48 and 50–62, which depend from Claims 39 and 49, respectively.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe no fees are due; however, should the Commissioner deem that any additional fees are due, including any fees for any additional extensions of time, the Commissioner is hereby authorized to debit said fees from deposit account number 50-4871.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457-2031.

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